



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/527,192	03/10/2005	Maki Okajima	03500.017559.	1113

5514 7590 11/07/2008
FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

DESAI, RITA J

ART UNIT	PAPER NUMBER
----------	--------------

1625

MAIL DATE	DELIVERY MODE
-----------	---------------

11/07/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/527,192	Applicant(s) OKAJIMA ET AL.	
	Examiner Rita J. Desai	Art Unit 1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 16-19 is/are pending in the application.
- 4a) Of the above claim(s) 16-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1625

DETAILED ACTION

Claims 4-15 have been cancelled.

Claims 1-3 are in the elected group and have been amended.

Claims 16-19 are withdrawn as being non-elected.

Response to applicants arguments.

Applicants have amended the claims to specific substituents and it obviates the 35 USC 112 rejection over claims 1-3. The arguments to overcome the 35 USC 103 rejection over EP 1097980 and its US equivalent are not found to be persuasive. Applicants have submitted a declaration indicating that they made the compounds of the prior art were not able to synthesize it. the process used by the applicants had several differences. the solvent system used for extractions and purification/ crystallization was not the same and that given by the prior art and hence it is not a true side by side comparison.

Applicants claim that their compounds have better activity is also not convincing as no data has been provided and also because the prior art teaches several other large groups . Further applicants argue that the prior art has compounds with the methylene linkages and direct bonds such as examples 133 and the activity is thus low in comparison to applicants compounds. This is confusing as applicants invention compounds are also directly linked.

Further for arguments sake, even if the exact compounds of the prior art may not be enabled , there is a lot of teaching that similar compounds can be made and that they would have the same activity. So to one skilled in the art, the prior art reference gives a clear guidance and a strong motivation to try and make similar compounds and expect

Art Unit: 1625

them to have the same activity, making it predictable to one skilled in the art and motivating them to try and make these compounds. So the rejection under 35 USC 103 has not been withdrawn. It is being repeated here and the action is made FINAL.

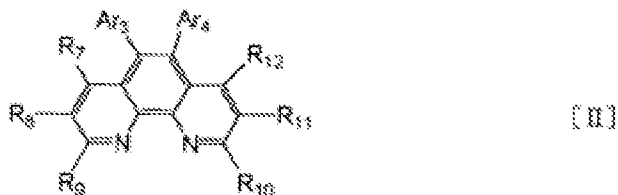
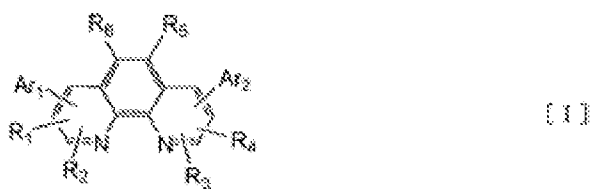
Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

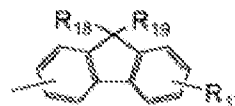
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 1097980, Shibnuma et al. 5/9/2001. JP 2001-131174, (Also see 6972334, US 7186469, US 7196225, US 7049470 , 7087310.)

Applicants claims are drawn to compounds of the formula



Art Unit: 1625

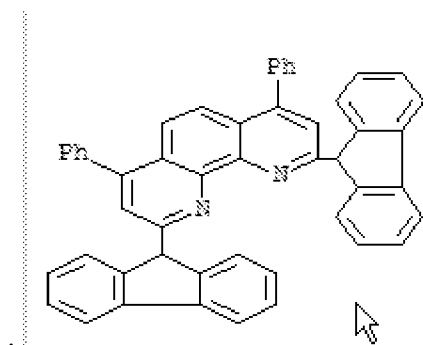


Wherein Ar₁ 1-4 are given by the formula

And the R's amongst others can be an aryl.

Scope & Content of Prior Art MPEP 2141.01

The reference teaches the compounds RN # 338734-80-8.



See pages 30, 31, 40 of the reference. (EP 1097980)

The reference also teaches other groups substituted on the phenanthroline.

The use of these compounds is also the same.

Difference between Prior Art and the claims MPEP 2141.02

The difference is the point of attachment of the fluorenyl group

Prima Facie Obviousness, Rational and Motivation MPEP 2142-2413

The reference teaches similar compounds, with same groups attached to it. The only difference is the position at which the fluorenyl group attaches itself. The use is the same. The reference discloses various other compounds with a variety of group and hence different attachments and hence one of skill in the art would expect that just

Art Unit: 1625

changing the position of attachment would retain the properties and hence be motivated to modify the compounds.

Conclusion

Claims 1-3 stand rejected.

Claims 15-19 are withdrawn.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rita J. Desai whose telephone number is 571-272-0684. The examiner can normally be reached on Monday - Friday, flex time..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres can be reached on 571-272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Rita J. Desai/
Primary Examiner, Art Unit 1625

R.D.
November 6, 2008